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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,276	07/31/2000	Hiroyuki Miyoshi	9369-50(T37-124477M/TH)	4209

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EXAMINER	
BRAHAN, THOMAS J	
ART UNIT	**PAPER NUMBER**
3652	

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/629,276	Applicant(s) MIYOSHI et al
	Examiner Thomas J. Brahan	Art Unit 3652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *Three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Oct 7, 2002* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-8* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the specification for claiming that the horizontal cross-sectional area of the shielding body is less than the horizontal cross-sectional area of the cage. This is new matter. Note that the specification does not state that the drawings are to scale, as to rely on the drawings for a teaching. Note also that even if the drawings were to scale, the drawings do not include a plan view as to show all of dimensions of the shielding body and the cage, as to indicate their relative sizes.

3. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention.

4. Claims 1-7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 1 has been amended to recite that the actuating device and shielding body are installed on a rooftop permanently attached to the building. It appears as though applicant's intent is claim that the shielding is permanently attached to the building. However the wording of the claim requires that the rooftop is the object that is permanently attached to the building.

b. It is unclear as to how applicant is considering that the shielding as both permanently attached, as recited in the penultimate line of claim 1, and readily detachable, as recited in the last line of claim 1. These are mutually exclusive features.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

7. Claim 1, as best understood, is rejected under 35 U.S.C. § 102(b) as being anticipated by Hakola EP 646,537. Hakola '537 shows an elevator apparatus comprising:

an actuating device including a sheave (12) around which a rope engaged with an ascending and descending cage (9) is wound, the cage having a cross-sectional area, the sheave being adapted to rotate thereby to move the rope with its rotation, and a driving section (8 or 10) for rotating the sheave, and

a shielding body (the motor casing, the gear casing, or these two casings together) for shielding the actuating device, the shielding body having a cross-sectional area less than the cross-sectional area of the cage;

wherein the actuating device and the shielding body are installed on a rooftop permanently attached to a building in which said ascending and descending cage is disposed, the shielding body being readily detachable from the rooftop.

8. Claims 1-3 and 5-7, as best understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Liebetrau et al in view of Hakola '537. Liebetrau et al shows the basic claimed elevator actuating device. It varies from claim 1 by not specifying how it is mounted to the building and elevator shaft. Hakola shows a method of installing an elevator which includes a shielding (49) attached to the rooftop of building. It would have been obvious to one of ordinary skill in the art to install the elevator actuator of Liebetrau et al within a rooftop shielding, as to have it mounted above the shaft without occupying the space within the shaft, as taught by Hakola '537. The size of the shielding would have been an obvious design consideration, especially when using a smaller actuating device, which would have been within the level of routine skill in the art. The speed-reducer, drive assembly, and brake of Liebetrau et al are arranged coaxially, as recited in claim 3. An output wheel of the speed-reducer constitutes the sheave, as recited in claim 5. The mounting of the support is to an upper surface of the rooftop, as recited in claim 6.

9. Claims 1, 3, 4, and 6, as best understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Latorre in view of Hakola '537. Latorre shows the basic claimed elevator actuating device. It varies from claim 1 by being mounted in the elevator shaft, not in a shielding on the rooftop. Hakola shows a method of installing an elevator which includes a shielding (49) attached to the rooftop of building. It would have been obvious to one of ordinary skill in the art to modify the elevator actuating device of Latorre by mounting it in a shielding on the roof of the building, to save elevator shaft space, as taught by Hakola '537. The size of the shielding would have been an obvious design consideration, especially when using a smaller actuating device, which would have been within the level of routine skill in the art.

10. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Liebetrau et al in view of Hakola '537. Liebetrau et al shows the basic claimed elevator actuating device. It varies from claim 1 by not specifying how it is mounted to the building and elevator shaft. Hakola shows a method of installing an elevator which includes a shielding (49) attached to the rooftop of building. It would have been obvious to one of ordinary skill in the art to install the elevator actuator of Liebetrau et al within a rooftop shielding, as to have it mounted above the shaft without occupying the space within the shaft, as taught by Hakola '537.

11. Applicant's remarks in the amendment entered upon the filing of the RCE have been considered, but as detailed in the above rejections, the new claims have been rejected as including new matter, and as including contradictory language. Furthermore rejections have been included which indicate that the term shielding also applies to motor and gear casings, and which also state that when using a smaller motor, using a smaller shielding would be obvious.

12. An inquiry concerning this action should be directed to Examiner Thomas J. Brahan at telephone number (703) 308-2568 on Mondays through Fridays from 9:30-7:00 EST. The examiner's supervisor, Ms. Eileen Lillis, can be reached at (703) 308-3248. The fax number for Technology Center 3600 is (703) 305-7687.

12/6/02

THOMAS J. BRAHAN
PRIMARY EXAMINER